

Remarks

The Office Action mailed November 14, 2007 has been carefully reviewed. The foregoing amendment has been made in consequence thereof.

Applicants believe that no extension of term is required and that no additional fee for claims is required. If any additional fee is required for an extension of term or claims, the Commissioner is hereby authorized to charge Deposit Account No. 01-2384.

Claims 32 and 34-56 are now pending in this application, of which claims 32, 35, 37 and 38 have been amended. Claim 33 has been cancelled without prejudice or disclaimer. Claims 35, 37 and 38 have been amended for clarity and consistency with other claims. It is respectfully submitted that the pending claims define allowable subject matter.

Applicants will now turn to the rejections made under 35 U.S.C. § 102 and § 103.

A. Johnson et al.

The rejection of claims 32-34 and 36-41 under 35 U.S.C. § 102(e) as being anticipated by Johnson et al. (U.S. Patent No. 2005/0045521) is respectfully traversed.

Claim 33 is cancelled without prejudice or disclaimer.

Johnson et al. disclose a soft-sided cooler having a spinning pointer (28) for entertainment purposes. The pointer (28) is cited in the Office Action as a product being offered for sale. Applicants respectfully disagree, and submit that the position taken in the Office Action is neither reasonable nor consistent with the ordinary meaning and understanding of a "product being offered for sale" in the marketplace, nor is the position taken anywhere supported by the teaching of the Johnson et al. reference. However, in the interest of expediting prosecution and moving the application closer to allowance, independent claim 32 has been amended to recite, in combination with the other recitations, that the product is removable from the body for use apart from the body and cover. That is, claim 32 now more clearly reflects the understanding of the

Applicants concerning a “product being offered for sale” as detailed in Applicants’ prior response.

Claim 32, as amended, expressly precludes the position of the Office that the pointer (28) may correspond to the “product” recited in the instant claims. As described by Johnson et al., the pointer (28) is provided for entertainment purposes in connection with indicia (32) on an interior of the top panel (18) of the cooler body (10). The pointer (28) clearly is not intended to be removable from the panel (18) for use apart from the panel (18). Removal of the pointer from the cooler body would apparently negate any value or desirability for providing it. Claim 32 is therefore not anticipated by Johnson et al., nor is Johnson et al. believed to be suggestive of the subject matter recited in claim 32.

Claims 34 and 36-41 depend from claim 32, and when the recitations of claims 34 and 36-41 are considered in combination with the recitations of claim 32, claims 34 and 36-41 are likewise not anticipated by Johnson et al.

For the reasons set forth above, Applicants request that the § 102(b) rejection of claims 32-34 and 36-41 be reconsidered and withdrawn.

B. Petrick et al. in view of Myers

The rejection of claims 32-56 under 35 U.S.C. § 103(a) as being unpatentable over Petrick et al. (EP 659,649) in view of Meyers (U.S. Patent No. 2,648,412) is respectfully traversed.

It is respectfully submitted that a *prima facie* case of obviousness has not been established.

Applicants note that the Petrick et al. reference is a foreign language reference, and unless Applicants are provided an English translation of the full text of the Petrick et al. disclosure, such a rejection would be procedurally improper. MPEP § 706.02 states that if a document is in a language other than English, and if the Examiner seeks to rely upon that document, a translation must be obtained so that record is clear as to the precise facts that the

Examiner is relying upon in support of the rejection. A full text translation of the Petrick et al. document has not been provided, and Applicants request reconsideration of the present rejections on this procedural ground.

Applicants have been provided with an English Abstract of the Petrick et al. reference, but as MPEP § 706.02 points out, in some cases the full text document may include teachings away from the invention that will preclude an obviousness rejection under § 103. As MPEP § 706.02 also notes, in *limited circumstances*, it may be appropriate to make a rejection in a non-final Office Action based in whole or in part on the abstract only. In such circumstances the translation may be supplied in the next Office Action. If the Office continues to rely on the Petrick et al. reference, Applicants request that the Office follow MPEP § 706.02 and provide a full English translation of the entire document. As it stands, the abstract does not appear to adequately support the present rejection.

For example, the abstract provided for the Petrick et al. reference refers to sides of a “flexible material” that can be folded together. Applicants submit that this does not itself connote a non-rigid container as claimed. Applicants point out that cardboard and plastic materials may very well be flexible materials that can be folded together, but they are not “non-rigid” materials within the meaning of the present claims. Indeed, Applicants overcame a rejection in its prior response on this very ground. The Petrick et al. abstract raises a reasonable question on this issue in the last sentence by referring to injection molded polypropylene, which Applicants understand is often used in rigid packaging. The abstract also refers to “stable-impact resistant materials” that appears to suggest rigidity. Applicants would be particularly interested in any expanded description of the specific materials used to fabricate specific components of the container, but at least preliminarily the abstract appears to describe a rigid container, and as such would be considerably less relevant to the claimed subject matter than the Office supposes.

Also, the Office Action concedes that Petrick et al. fails to disclose a closure member or a handle, but Applicants would be particularly interested in whether the full text of the documents provides any discussion therein that would negate a desirability of such features. To the extent that Applicants understand the Petrick et al. abstract and drawings, it appears doubtful whether

any motivation would have existed to provide a handle or a closure member to the Petrick et al. container because the folding nature of the container would apparently be impaired by closure members and handles. Also, a zipper mechanism would appear to be unworkable with folding walls that are referred to in the Petrick et al. abstract.

Meyers discloses a suitcase with soft sides and a zipper. Its relevance, however, is far from clear to the specific subject matter claimed. The Meyers suitcase is believed to be akin to the utility bags (also having soft sides and zippers) previously cited against the claims and withdrawn in light of Applicants arguments against the rejections. That is, the Meyers suitcase is also a general purpose bag that conventionally has been sold apart from any product, and consequently is not a "product package." As such, its disclosure is believed to be generally irrelevant to the invention as claimed, or at least no more relevant than the utility bag art that the Office has apparently decided not to continue to rely upon to reject the claims.

In short, the Office has yet to articulate any explicit rational underpinning, supported by objective evidence, that the presently claimed subject matter would have been obvious to one of ordinary skill in the art at the time of the invention. Applicants note that no less than five Office Actions on the merits have been issued in the present prosecution, and the Office is apparently struggling to find any reference that actually teaches or discloses product and footwear being offered for sale in connection with the packages presently claimed in the pending independent and dependent claims, and also is struggling to articulate a reasoned and rational underpinning for a conclusion that the claims are obvious, yet nonetheless has demonstrated a stubborn unwillingness to allow the claims. Absent some evidence that presents a *prima facie* case of unpatentability of the claims, which despite numerous opportunities for searching by different examiners, has yet to be properly supplied by the Office, Applicants respectfully request that the claims be allowed and that the application be passed to issue. It is believed that the Office policy of compact prosecution, as well as notions of fundamental fairness, points toward a prompt resolution of the issues in Applicants favor.

Applicants accordingly request reconsideration and withdrawal of the § 103(a) rejection of the claims as being unpatentable over Petrick et al. in view of Meyers.

Conclusion

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully Submitted,



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